

Remarks/Arguments

Claims 120-126, 129-131 and 135-138 are pending in this application. Claims 124-126, 129-131 and 135-138 have been indicated as allowable. Without acquiescing to the propriety of the rejection, but merely to expedite prosecution of this case, Claims 120 and 121 have been canceled without prejudice or disclaimer. The rejections to the presently pending claims are respectfully traversed.

Claim Rejections – 35 USC § 112, first paragraph- enablement

Claims 120-123 are rejected under 35 U.S.C. §112, first paragraph for lack of enablement. In the rejection, the Examiner erroneously rejects Claims 124-126, 129-131, 135-138 when in fact, these claims were found to be allowable (see Office action summary -page 2). The Examiner asserts that "the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims". For the reasons outlined below, Applicants respectfully disagree.

Without acquiescing to the propriety of the rejection but merely to expedite prosecution in this case, Applicants hereby cancel claims 120 and 121 and therefore rejections to these claims are moot.

The Legal Test for Enablement was recited in the previous response. Applicants submit that the specification provides sufficient information to enable the claimed invention. Claims 122 and 123 only encompass those nucleic acids that encode polypeptides testing positive in the chondrocyte redifferentiation assay. The chondrocyte redifferentiation assay is a well-established assay and based on the detailed description for cloning variant nucleic acids of SEQ ID NO: 118 in the specification, and based on the advanced knowledge of one skilled in the art, Applicants submit that one of skill in the art would have known how to prepare nucleic acids with 95-99% identity to the nucleic acids encoding polypeptide of SEQ ID NO: 119 or nucleic acids of SEQ ID NO: 118, without undue experimentation, at the time the invention was made. The positions at which the changes are to be made are not an issue, since Applicants only claim those variant nucleic acids whose encoding polypeptides test positive in the chondrocyte redifferentiation assay. Based on the step-by-step disclosure of the assay in the specification, one skilled in the art

would know exactly how to make and use the invention. Thus, the currently pending claims are fully enabled, and Applicants request that the present 35 U.S.C. §112, first paragraph rejections to the pending claims be withdrawn.

Claim Rejections – 35 USC § 112, first paragraph- written description

Claims 120-123 are rejected under 35 U.S.C. §112, first paragraph for failing to comply with the written description requirement. In the rejection, the Examiner erroneously rejects Claims 124-126, 129-131, 135-138 when in fact, these claims were found to be allowable (see Office action summary -page 2). Applicants respectfully traverse this rejection to the pending claims.

Arguments

Without acquiescing to the propriety of the rejection but merely to expedite prosecution in this case, Applicants hereby cancel claims 120 and 121 and therefore the rejections to these claims are moot.

The legal standard for Written Description were discussed in the previous response. Claims 122 and 123 are directed to nucleic acids having 95% and 99% sequence identity, respectively, to the nucleic acid sequence of SEQ ID NO: 118 and which encode polypeptides that induce chondrocyte redifferentiation. Thus, the pending claims are now drawn to a genus of polypeptides defined both by structural and functional features, and only those nucleic acids encoding polypeptides that test positive in the chondrocyte redifferentiation assay are encompassed by these claims.

Applicants point out that the instant specification describes detailed methods for the determination of percent identity between two nucleotide sequences. The specification further describes methods to *identify* nucleotide sequences having at least 95-99% identity to SEQ ID NO:118, 'wherein the polypeptide encoded by said nucleic acid induces chondrocyte redifferentiation' and teaches one of ordinary skill in the art, in a step-by-step method, to test the nucleic acids encoding these variants in the chondrocyte redifferentiation assay, at least in Example 159 of the instant specification. Accordingly, the specification provides adequate written description for making and using the nucleic acids of Claims 122 and 123 and for these

reasons, Applicants respectfully request that the rejection be withdrawn and the claims be allowed.

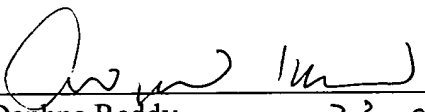
Conclusion

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641, referencing Attorney's Docket No. 39780-2730 P1C51. Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: June 17, 2005

for 
Daphne Reddy
Reg. No. 53,507 22,055

HELLER EHRMAN WHITE & McAULIFFE LLP

Customer No. 35489

275 Middlefield Road

Menlo Park, California 94025

Telephone: (650) 324-7000

Facsimile: (650) 324-0638

SV 2131837 v1
6/16/05 11:37 AM (39780.2730)